

## REMARKS

This paper is filed in response to the decision from the Board of Patent Appeals and Interferences of February 19, 2004. Claims 57-83 and 97-103 are pending in the application. Claims 62-64, 66, 67, 70, 71, and 73-83 are withdrawn from consideration, leaving Claims 57-61, 65, 68, 69, 72, and 97-102. In its decision, the Board sustained the rejection of Claims 57-59, 65, 68, and 69 as being anticipated under 35 U.S.C. § 102 based on Spademan; and sustained the rejection of Claim 102 as being anticipated under 35 U.S.C. § 102 based on Battistella. The Board entered a new rejection of Claims 57-61 under 35 U.S.C. § 112, second paragraph. The Board reversed the rejection of Claims 72, 97 and 98 under 35 U.S.C. § 102(b) based on Battistella; and the Board reversed the rejection of Claims 99, 100 and 101 under 102(b) based on Otieri. There being no other rejections of Claims 72 and 97-101, these claims are allowed.

Claim 57 has been amended under the provisions of 37 C.F.R. § 1.96(b)(1).

The amendment incidentally overcomes the rejection of Claims 57, 58 and 59 under 35 U.S.C. § 102(b) based on Spademan.

Rehearing of Claims 65, 68, 69 and 102 is respectfully requested.

### The Rejection on New Grounds of Claims 57-61 Under 35 U.S.C. § 112, Second Paragraph

Claims 57-61 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claim 57 has been amended to recite:

....

a tension adjustment member connected to the cable members for altering the length of said cable members, said length being the length between the tension adjustment member at the rear of the boot and the one general position at the forward portion of the boot.

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As understood by applicants, the decision by the Board found Claim 57 indefinite because the phrase "for altering the length of the cable" is lacking explanation in the Specification regarding such feature and there is no description of a length altering mechanism, and further it did not appear to the Board that length altering actually occurs. Applicants have amended Claim 57 to more specifically recite that which applicants regard as the invention. Namely, the length that is being altered is the length between the tension adjustment member at the rear of the boot and the one general position at the forward portion of the boot. While the overall length of the cable members are not actually altered, the length between the tension adjustment member at the rear of the boot and the one general position at the forward portion of the boot is altered depending on where the cables are attached to the tension adjustment member.

Thus, for example, as seen in FIGURES 13 and 15, one embodiment of a tension adjustment member is shown that includes shelf dogs 128 and 130 in spaced relation to each other, dog 128 being positioned closer to shaft 120 than dog 130. The engagement member extends away from the end receiving the shaft and includes first and second shelf dogs 128 and 130 in spaced relation to each other, dog 128 being positioned closer to shaft 120 than dog 130. Thus, as can be appreciated, moving the cable 126 from shelf dog 128 to shelf dog 130, as shown in FIGURE 15, will alter the length of the cable 126 that is between the engagement member 122 at the rear of the boot and the one general position at the forward portion of the boot. This is because more of cable resides within the engagement member 122 than outside of the engagement member 122. This altering of cable length will be apparent from a comparison of FIGURE 13 with FIGURE 15. Please see the specification on page 13, lines 12-25.

Referring to FIGURE 27, an alternate embodiment of a tension adjustment member for altering the length of the cable members is shown, the length being altered is again the length between the tension adjustment member at the rear of the boot and the one general position at the

forward portion of the boot. In this embodiment, the engagement member 122 includes plural pairs of slots 272 in spaced relation to each other along the length of member 122. Cable 126 is cut at the end to provide two separate ends. A cylindrical keeper 274 is fused onto the end of each cable, where the keepers are sized so as to be received in any one of the slots 272. Thus, it is apparent that by placing the keeper 274 into either the lower or upper slot will result in altering the length of cable 126 between the engagement member 122 at the rear of the boot and the one general position at the forward portion of the boot. This is because the cable ends are pulled into slots 272 that are further spaced apart from one another. Please see the Specification on page 14, lines 18-35.

FIGURE 28 is another embodiment of a forward lean adjustment member 122. This embodiment has a threaded shaft 276 that extends substantially the length of member 122. The two ends of cables 126 are secured to a stud 278 that is in threaded engagement with the shaft 276. A handle 208 mounts to one end of the shaft to enable the shaft to be rotated about a central axis. Stud 278 will move upwardly and downwardly along axis 284 as the handle 280 is rotated, altering the position of the cable ends 126. Therefore, the length of the cable that is between the tension adjustment member and the one general position at the forward portion of the boot is altered by turning the handle 280. While the overall length of the cables is not altered, the length of the cable that is altered is the length that is between the tension adjustment member at the rear of the boot and the one general position at the forward portion of the boot. See the Specification on page 15, lines 1-8.

FIGURE 37 represents yet another embodiment of an adjustment member for altering the length of the cables, the length being the length between the tension adjustment member at the rear of the boot and the one general position at the forward portion of the boot. This member employs a rotatable threaded shaft 276 with a pulley 277 threadably mounted thereto. A knob 280 mounts to one end of shaft 276 to enable turning the shaft. Cable ends 126 are fixed in

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position to a plate 279 and extend over the pulley and back up over guides 281, ultimately extending out of the body of the engagement member. In use, as knob 280 is turned, the pulley travels up and down the extent of the shaft, altering the effective length of the cables, the length being the length between the tension adjustment member at the rear of the boot and the one general position at the forward portion of the boot.

Applicants respectfully submit that amended Claim 57 is not indefinite for the reasons discussed above. Support for the amendment is found in the passages discussed above. Accordingly, withdrawal of the rejection of Claims 57-61 under 35 U.S.C. § 112, second paragraph, is respectfully requested.

The Rejection of Claims 57-59 Under 35 U.S.C. § 102

Claims 57-59 are rejected under 35 U.S.C. § 102(b) as being anticipated by Spademan.

Applicants believe that Claim 57 is not anticipated by Spademan even without the present amendment.

Applicants note that the Spademan reference first of all does not have medial and lateral side cable members on the boot wherein a tension adjustment member is connected to the cable members. The meaning of a "tension adjustment member is connected to the cable members" is clear. Each one of the medial and the lateral side cable members are connected to the tension adjustment member. In direct contrast to Claim 57, the Spademan reference describes that one of the cables is attached to a point designated 16 which therefore cannot be connected to a tension adjustment member. Spademan describes:

Coupled at one end to the left flap means 5 at a point designed 16 there is provided a cable means 17. The cable means 17 is routed from the cuff means attachment point 16 through one of the cable guiding grooves 12, 13 of the buckle assembly 10 across the exterior surface of the flap means 5 toward the rear of the ski boot 1, as shown more clearly in FIG. 2.

Col. 4, lines 30-36.

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Applicants also make reference to Col. 4, line 68, through Col. 5, line 5, which states:

As the cable means 17 is pulled rearwardly relative to the cuff means 3 during forward lean, the cable means pulls the right flap means 4 using the buckle assembly 10 and the left flap means 5 because of its attachment to the flap means 5 at point 16.

Thus, applicants believe that the cable 17 clearly ends at point 16 and therefore cannot be connected to a tension adjustment member as recited in Claim 57.

In the alternative to the discussion above, applicants submit that in amending Claim 57 in view of the new rejection by the Board based on Section 112, applicants have further provided more structure that distinguishes Claim 57 from the Spademan reference. Thus, because Spademan describes a medial or lateral side cable member, wherein the cable member is fixed at point 16 and cannot be connected to the tension adjustment member at the rear of the boot as claimed, the Spademan reference is not anticipatory. Furthermore, applicants submit that there is no altering of the length of the cable members as claimed; the length being the length between the tension adjustment member at the rear of the boot and the one general position at the forward portion of the boot.

Accordingly, for all the reasons discussed above, withdrawal of the rejection of Claim 57 based on 35 U.S.C. § 102(b) is respectfully requested.

Claims 58 and 59 depend from Claim 57; therefore, Claims 57-59 are allowable.

The Rejection of Claims 65, 68, and 69 Under 35 U.S.C. § 102(b)

Claims 65, 68, and 69 are rejected under 35 U.S.C. § 102(b) as being anticipated by the Spademan reference.

Claim 65 recites having both a medial and lateral side cable member. The meaning of lateral and medial cable is intended to convey that a cable comes from the lateral and the medial side of the upper rear portion of the boot where the cables attach to the adjustment member, and then each cable passes to one side of the boot upper portion, therefore, the cables are a lateral

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cable and a medial cable. Spademan does not have a medial and a lateral cable, as recited in Claim 65; Spademan has cables coming from only one side of the boot. Thus, Spademan has either two lateral cables or two medial cables, depending on whether the boot is for a right or left foot. Furthermore, one of the cables is fixed to the point 16, and not to the tension adjustment member. Accordingly, Spademan does not describe both a medial and a lateral side cable member attached to a front portion of the boot at only one general position thereon. As shown in the marked-up front page of the Spademan patent, provided by the Examiner, as part of the Office Action, the purported lateral side cable member and the medial side cable member originate from the same side and converge at the buckle on the medial side, and therefore, the cables cannot be a medial and a lateral cable. Spademan fails to at least describe both a medial and a lateral cable member on the boot. For at least this reason, Spademan does not anticipate Claims 65, 68, and 69.

The Rejection of Claim 102 Under 35 U.S.C. § 102(b)

Claim 102 is rejected under 35 U.S.C. § 102(b) as being anticipated by the Battistella reference. Applicants submit that the construction of the word "either" is in error for the following reasons. While the dictionary definition of "either" can be "one and the other of two," or "one or the other of two," applicants believe that the Board erred in construing "either" to be "one or the other of two." If as the Board stated, the construction of "either" is one or the other of the two sides, then the requirement of Claim 102 that "cables (plural) from either (meaning one or the other) side of the upper, rear ankle portion" is not shown or described in the Battistella reference because Battistella never shows plural numbers of cables on one side of the upper, rear ankle portion. Battistella only shows one cable on both sides of the upper, rear ankle portion. Thus, under the Board's construction of the word "either," the Battistella reference would not anticipate Claim 102. Applicants believe that given two possible meanings of a claim term, the definition chosen should be the one that is consistent with what is implied from the specification

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so that the chosen definition would read on at least one of the embodiments. If the meaning of "either" is "one or the other" there is no embodiment that has cables on one side of the upper rear ankle portion of the boot. All embodiments have one cable on each side of the upper rear ankle portion of the boot.

Ultimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelope with the claim. . . . The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction. *Renishaw PLC v. Marposs Societa'per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998).

Battistella never describes, "cables from either side (meaning both sides) of the upper, rear ankle portion attached to the lower front foot portion, wherein forward portions of said cables are attached at only a single general position or the lower front foot portion."

Accordingly, the withdrawal of the rejection of Claim 102 based on 35 U.S.C. § 102(b) is respectfully requested.

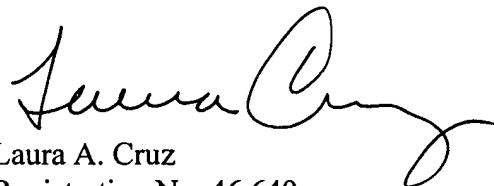
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CONCLUSION

Claim 57 is not anticipated by Spademan based, in part, on the amendment necessitated by the new rejection. Therefore, Claims 57-59 are allowable. Applicants respectfully request rehearing of Claims 65, 68, 69, and 102.

Respectfully submitted,

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